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In the Supreme Court of the United States

OCTOBER TERM, 1997

IN RE ROBERT LONARDO AND RESTORATIVE CARE OF AMERICA, INC.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

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QUESTION PRESENTED

Whether the Commissioner of Patents and Trademarks may consider obviousness-type double patenting during reexamination.

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OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-21a) is reported at 119 F.3d 960. The consolidated opinions of the Board of Patent Appeals and Interferences (Pet. App. 26a-61a) are unreported.

JURISDICTION

The judgment of the court of appeals (Pet. App. 22a) was entered on July 8, 1997. A petition for rehearing was denied on August 29, 1997. Pet. App. 23a-25a. The petition for a writ of certiorari was filed on November 28, 1997 (the day after a federal holiday). The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

1. This case involves the doctrine of "obviousness-type" double patenting. Prior to 1994, the expiration date for the seventeen-year protection afforded to

patented inventions was calculated solely on the basis of the date on which the patents were issued by the Patent and Trademark Office (PTO). By contrast, the effective filing date of a claim determined the priority of the issued patent.[1] Accordingly, if a patentee filed an application for an invention that was not patentably distinct from a previous invention, and if the second application had the same effective filing date as the original invention, then patentees could effectively increase the term of protection Congress intended to afford to a patented invention. To forestall this result, inventors are precluded by the doctrine of "double patenting" from obtaining additional valid patents for patentably indistinct inventions unless they forgo the increased period of protection by filing a terminal disclaimer under 35 U.S.C. 253.[2] See *In re Longi*, 759 F.2d 887, 892 (Fed. Cir. 1985).

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[1] The effective filing date of an application turns upon when all of the necessary support for a claim on an invention is disclosed in the specification pursuant to 35 U.S.C. 112. Thus, a patentee's second claim, although filed after the patentee's original claim, could have the same effective filing date as the original claim.

[2] Section 253 provides in relevant part:

> A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent and Trademark Office * * * .
>
> In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

Obviousness-type double patenting concerns a patentee's attempt to obtain a second patent for claims that are not patentably distinct from the claims of the first patent and thereby obtain an unwarranted extension of his patent term. Pet. App. 11a. Generally, obviousness-type double patenting involves multiple applications with the same effective filing date for patents on similar devices.[3] Rejections of patent application claims for obviousness-type double patenting are based on the patentee's earlier issued patent. Although such a patent is a printed publication, it is not technically "prior art" to the rejected application claims since the patent and the application at issue have common filing dates. See Pet. App. 11a-12a.

Congress has effectively diminished the problems associated with double patenting with the enactment in 1994 of the Uruguay Round Agreements Act, Pub. L. No. 103-465, § 532, 108 Stat. 4984 (codified at 35 U.S.C. 154). The Act changed the prior 17-year patent term and provides that the patent term be measured from the date of filing. Under the Act, for patents in force on or applied for before June 8, 1995, the patent term will be the greater of: (1) twenty years from the date of filing the application; or (2) seventeen years from the date of issuance. See 35 U.S.C. 154(c)(1). Accordingly, with the passage of the Uruguay Round Agreements Act, cases, such as the present, involving obviousness-type double patenting will increasingly disappear from the legal landscape.

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[3] "Same invention" double patenting is based upon 35 U.S.C. 101, which prohibits a patentee from obtaining more than one patent for a single invention. Pet. App. 11a. Same invention double patenting is not at issue in this case.

2. Petitioner is the inventor/assignee of expired U.S. Patent Re. 33,762 ('762), as well as U.S. Patent No. 5,269,748 ('748), U.S. Patent No. 5,298,013 ('013), and application serial no. 08/218,756 ('756), all of which are directed to a therapeutic leg and foot device. See Pet. App. 2a-4a. Specifically, the claimed invention consists of an L-shaped cast that is attached to a patient's foot using an open-heeled sandal. *Id.* at 3a-4a. The novelty of the claimed invention is that the L-shaped cast is configured such that a space exists between the right angle portion of the cast and the patient's heel, thus preventing sores from forming on a bedridden patient's heel. See *ibid.*

In 1970, petitioner filed his original application for a patent for the therapeutic leg device. The patent on that original invention was issued in 1976. Pet. App. 27a. Thereafter, petitioner applied for other patents for a therapeutic leg device. Petitioner, however, did not disclose to the PTO the relation of the subsequent applications to the 1976 patent on the original invention. As a result, patents based upon the subsequent applications were issued in 1993 and 1994. See *id.* at 26a, 37a. Petitioner's subsequent applications claim the same effective filing date as the original invention, 1970. Accordingly, the protection for the patents for petitioner's subsequent applications would begin in 1993 and 1994, and their priority would be calculated on the basis of 1970. Thus, if successful, petitioner would have effectively circumvented the limits of the protection Congress intended to provide to new inventions.

It is undisputed that the PTO had statutory authority to reject, in the first instance, the claims of the subsequent applications on grounds of double patenting. However, because petitioner failed to disclose to

the PTO the obvious relation of the subsequent applications to the original patent, the PTO never considered the issue of double patenting prior to the issuance of the patents in 1993 and 1994. Pet. App. 34a.

Thereafter, third parties requested that the PTO reexamine the 1993 and 1994 patents. The PTO conducted a reexamination proceeding for both petitioner's '748 and '013 patents during which the patent examiner rejected all of the claims at issue based on the doctrine of double patenting in view of petitioner's expired '762 patent. See Pet. App. 62a-73a, 95a-105a. For similar reasons, the examiner also rejected the sole claim of the original '756 application. *Id.* at 106a-116a. In each case, the examiner determined that the claims were not patentably distinct from the claims of the '762 patent and that if they were allowed, petitioner would be improperly extending the term of his expired '762 patent. *Id.* at 64a-66a, 97a-99a, 108a-110a. Since petitioner's '762 patent, which is the basis for the double patenting rejections, has expired, a terminal disclaimer could not cure the rejections. *Id.* at 11a.

Petitioner appealed the examiner's decisions to the Board. Relying on the language of Section 303 of Title 35 and its own precedent, the Board determined that the Commissioner may consider double patenting during reexamination. See Pet. App. 28a-29a, 39a-40a. The Board then rejected all of the claims since they would have been obvious in view of the expired claims of petitioner's '762 patent.[4] *Id.* at 29a-34a, 42a-47a.

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[4] The examiner's initial decision made reference to a doctrine of "non-obvious double patenting" in the rejection of petitioner's claims (Pet. App. 68a), and petitioner's arguments

The Board also determined that if any of the claims were allowed, petitioner would be improperly extending the term of his expired '762 patent. *Id.* at 30a-32a, 40a-42a.

Petitioner then appealed to the Federal Circuit. The court affirmed, holding that "the PTO was authorized during reexamination to consider the question of double patenting." Pet. App. 13a. The court based its holding on the language of the reexamination statute, its legislative history, and the purpose underlying the doctrine of double patenting. The court then reached the merits of the case and determined that the claims of petitioner's '748 patent (*id.* at 14a-16a), '013 patent (*id.* at 16a-17a), and '756 application (*id.* at 17a-18a) were all invalid based on obviousness-type double patenting in view of petitioner's expired '762 patent. The court of appeals determined that each of the additional limitations contained in the claims was "an obvious modification of the device defined in the '762 claims." *Id.* at 15a. In addition, the court of appeals determined that since petitioner's expired '762 claims were "species" (*i.e.*, a subset) of the broader "genus" claims on appeal, the claims were invalid. *Ibid.* Finally, the court held that there was "no patentable distinction" between the claims at issue and the claims of petitioner's expired

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in its petition to this Court in part turn upon whether this is a basis on which the PTO may reject a claim. Pet. 13-17. On appeal of the examiner's decision, however, the Board concluded that petitioner's second application was an instance of obviousness-type double patenting. Hence, the Federal Circuit correctly concluded that petitioner's contentions regarding non-obviousness double patenting were not relevant to its decision. Nor are they relevant here in petitioner's quest for review of that decision. Pet. App. 14a.

'762 patent. *Ibid.* Judge Newman dissented in part, because in her view "[d]ouble patenting is not a ground of rejection that is permitted to be raised under the reexamination statute." *Id.* at 19a.

ARGUMENT

Further review of this case is not warranted. Due to a change in the patent laws, the primary issue raised by petitioner has little prospective importance. Moreover, the court of appeals' decision rejecting all claims based on obviousness-type double patenting is correct and does not conflict with any decision of this Court or any other court of appeals.

1. In 1994, Congress amended the patent laws to require that the patent term be measured from the date of filing. See Uruguay Round Agreements Act, Pub. L. No. 103-465, § 532, 108 Stat. 4984 (codified at 35 U.S.C. 154). That change in law effectively cures the double patenting problem for applications with the same effective filing date. As a result of the Act, most applications filed on or after June 8, 1995, which issue as patents will expire twenty years from the application's effective filing date. 35 U.S.C. 154. Thus, except for those few patents eligible for a term extension under 35 U.S.C. 154(b), for most such applications filed after June 8, 1995, the resulting patents will expire on the same date. Consequently, in most cases a patentee will no longer be able to extend his patent term through double patenting. This change in law greatly diminishes the prospective importance of the primary issue presented in this case.

2. The court of appeals' decision is correct and is fully consistent with the language of the reexamination statute. That statute authorizes the Commissioner to reexamine an issued patent when he

determines that a "substantial new question of patentability" exists. 35 U.S.C. 303(a). Although reexamination may be *requested* by any person based on "prior art consisting of patents or printed publications," 35 U.S.C. 301 and 302, the Commissioner *determines* whether a substantial new question of patentability exists "with or without consideration of other patents or printed publications." 35 U.S.C. 303(a). Moreover, on his own initiative, "the Commissioner may determine whether a substantial new question of patentability is raised by *patents and publications* discovered by him." *Ibid.* (emphasis added).

By its plain terms, Section 303(a) provides that in determining whether a substantial new question of patentability exists to initiate a reexamination proceeding, the Commissioner may consider "other patents or printed publications" in addition to those cited pursuant to Sections 301 and 302. 35 U.S.C. 303(a). In addition, Section 303(a) provides that at any time, the Commissioner himself may determine whether a substantial new question of patentability exists based on "patents and publications discovered by him." *Ibid.* As petitioner concedes (Pet. 9-10), the language of Section 303(a) does not restrict the Commissioner to considering only prior art. Upon comparing the language of Sections 301 and 302 with that of Section 303, the court of appeals correctly determined that Congress did not intend that the phrases "patents and publications" and "other patents or printed publications" in Section 303(a) should be limited to prior art patents or printed publications. Pet. App. 12a. Cf. *Crawford Fitting Co.* v. *J. T. Gibbons, Inc.*, 482 U.S. 437, 445 (1987) (noting this Court's

longstanding practice of construing statutes on the same subject matter together or "*in pari materia*").

3. The legislative history of the reexamination statute supports the court of appeals' reading of the statute's plain meaning. See Pet. App. 12a-13a. That history indicates that, in determining the scope of reexamination, Congress gave particular consideration to issues of cost and administrative expertise. See H.R. Rep. No. 1307, 96th Cong., 2d Sess. 3-4 (1980) ("Reexamination will permit efficient resolution of questions about the validity of issued patents without recourse to expensive and lengthy infringement litigation. * * * A new patent examination procedure is needed to permit the owner of a patent to have the validity of his patent tested in the Patent office where the most expert opinions exist and at a much reduced cost."). Thus, although Congress did not provide for reexamination to address all validity issues, it did authorize reexamination in those areas within the PTO's everyday expertise that rely on evidence that is both readily available and best considered by the PTO—*i.e.*, patents and printed publications. See Pet. App. 12a-13a.

Double patenting, which involves an examination based on the patentee's readily available other *patents*, is precisely the type of issue Congress meant to be considered during reexamination. See H.R. Rep. No. 1307, *supra*, at 7 (reexamination statute "would permit the Commissioner to initiate reexamination without a request upon a determination that a substantial new question of patentability is raised by patents or publications discovered by him or cited under the provisions of Section 301"); Pet. App. 13a. As the court of appeals correctly observed, such consideration of "patents or printed publications," 35

U.S.C. 303(a), comports with the PTO's expertise and does not significantly increase the cost of reexamination. See Pet. App. 13a ("[T]he cost of examination is not significantly increased by having the PTO consider the ground of double patenting, as it involves issues of claim identity and obviousness, well within the PTO's everyday expertise.").

In addition to cost and agency expertise, Congress was also concerned with limiting potential harassment of patentees by third parties. H.R. Rep. No. 1307, *supra*, at 4 ("Patent office reexamination will greatly reduce, if not end, the threat of legal costs being used to "blackmail" [patent] holders into allowing patent infringements or being forced to license their patents for nominal fees."); Pet. App. 12a. Congress thus limited third parties to challenges based on "prior art." However, Congress's concerns over harassment of patentees by third parties is inapplicable to the Commissioner's reexamination of obviousness-type double patenting, since the primary basis for such a reexamination is the patentee's own prior patent, readily available for review and well within the Commissioner's expertise. Accordingly, the court of appeals properly concluded that Congress's objectives, as expressed in the Act's legislative history, are best served by having the PTO, as opposed to a district court, consider questions of double patenting in the first instance. *Ibid.*[5]

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[5] Petitioner's attempt (see Pet. 9-10) to exclude the consideration of double patenting from reexamination by relying on the phrase "preexisting technology" as it appears in the legislative history is not persuasive. The particular discussion in the legislative history relied upon by petitioner states that the "new procedure will permit *any party* to petition the patent office." H.R. Rep. 1307, supra, at 3, (emphasis added). Neither

4. As noted by the court of appeals, and as this case illustrates, the public interest is best served by allowing the Commissioner to consider issues concerning double patenting during reexamination since the continued maintenance of a patent that is invalid based on double patenting would be an imposition on the public. Pet. App. 13a.

In this case, petitioner has not explained why the '762 patent was not discussed during the initial examination of the '748 or '013 patents. The information about the interrelation of the relevant applications was within petitioner's knowledge, and would not generally be known to the examiner absent petitioner's referring to the issue. Thus, precluding the Commissioner from raising the issue during reexamination would reward petitioner's nondisclosure by allowing petitioner to maintain the '748 and '013 patents despite the fact that the '762 patent—which covers a patentably indistinct invention—has already expired. Such a result would enable petitioner to exclude others from practicing the claimed invention for an unwarranted extension of time, unless and until a potential infringer is willing to undergo costly litigation. Moreover, the result petitioner seeks would encourage applicants to withhold double patenting information from the PTO during original prosecution based on the knowledge that the PTO could not address the issue later during reexamination.

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the statute nor its legislative history, however, contemplates having the Commissioner petition his own office to initiate reexamination. Thus, this discussion relates to the procedures in Sections 301 and 302, which cover requests for reexamination by "any person," not Section 303(a), which covers the Commissioner's determination in reexamination. See 35 U.S.C. 301-303(a).

5. Contrary to petitioner's assertion, the court of appeals' decision is fully consistent with its prior case law. In any event, any inconsistency in that court's own decisions would be for the court of appeals, rather than this Court, to resolve. *Wisniewski* v. *United States*, 353 U.S. 901, 902 (1957).

Petitioner contends that the court's decision is inconsistent with its previous decisions in *In re Etter*, 756 F.2d 852 (Fed. Cir.) (en banc), cert. denied, 474 U.S. 828 (1985), *In re Recreative Technologies Corp.*, 83 F.3d 1394 (Fed. Cir. 1996), and *In re Portola Packaging, Inc.*, 110 F.3d 786 (Fed. Cir. 1997). However, none of those cases involved the issue of double patenting. In addition, prior to this case, the court of appeals never addressed the issue of whether the Commissioner may consider double patenting during reexamination.

Etter held that 35 U.S.C. 282, which deals with the presumptions and defenses involved in district court patent litigation, is not applicable to reexamination proceedings. 756 F.2d at 858. In *Recreative Technologies*, the court of appeals held that the Commissioner is barred on reexamination from considering "questions of patentability that were decided in the original examination." 83 F.3d at 1398. In *Portola* (authored by same judge as the present opinion (Lourie, J.)), the court determined that during reexamination, the Commissioner may not consider questions based on art previously cited during the patent's initial examination. 110 F.3d at 789. Here, by contrast, since the issue of double patenting was never raised and the '762 patent was not even considered during the original prosecution of petitioner's '748 and '013 patents, neither *Recreative Technolo-*

gies nor *Portola* suggests the Commissioner is barred from considering the issue during reexamination.

6. Petitioner's argument (Pet. 17-20) that reexamination should be limited to only those specific issues recited in the reexamination order is without merit. Nothing in the statute, legislative history, or regulations suggests that the Commissioner must order a new reexamination each time a new issue arises. In fact, new issues often arise during reexamination since the patentee is free to amend his claims. Even petitioner notes that only 24 percent of patents reexamined survive with no changes to the claims. Pet. 7. Thus, new issues almost always arise in reexamination. Moreover, petitioner's argument is inconsistent with the statutory requirement that reexamination proceedings "be conducted according to the procedures established for initial examination." 35 U.S.C. 305. Under such procedures, the PTO examination "will be as complete as possible as to all matters." 37 C.F.R. 1.105. Finally, since petitioner was given both ample notice as well as several opportunities to respond to the double patenting rejection, petitioner was in no way unfairly prejudiced by the Commissioner's procedure in this case.

7. Petitioner's argument regarding claim construction (see Pet. 20-22) goes to the specific facts of this case, not to a question of law. Petitioner defined an element of his claims using "means-plus-function" language.[6] Specifically, the claims recite a "means

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[6] Section 112 provides that an element of a claim may be expressed in terms of a means or step for performing a specified function, instead of being expressed in terms of its structure. This Section requires that such claims "shall be construed to cover the corresponding structure * * *

for releasably securing" the cast to the patients' foot. Means-plus-function language is interpreted by considering the specification. Here, petitioner's specification discloses an open-heeled sandal as the means for securing the cast to the patient's foot. Thus, the court of appeals correctly construed the means for securing claim language as including the open-heeled sandal disclosed in petitioner's specification. In any event, that fact-specific matter does not warrant this Court's review.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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described in the specification and equivalents thereof." 35 U.S.C. 112.